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EXAMINER

LUONG, VINH

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PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHIHIDE ITEYA

Appeal 2007-0131
Application 09/785,026
Technology Center 3600

Decided: February 28, 2008

Before WILLIAM F. PATE, III, MURRIEL E. CRAWFORD, and
ANTON W. FETTING, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1, 3 to 27. Claim 2 has been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented a bicycle control device (Specification 1).

Claim 1 under appeal reads as follows:

1. A bicycle switch mounting assembly for holding a computer switch, comprising:
 - a bicycle control device having a top surface, the top surface defining a recess therein, the recess having a bottom wall and a side wall connected to the bottom wall;
 - an operation control button with an outer periphery having a shape, wherein the operation control button is connected to the bicycle control device and movable within the recess, and wherein the recess has a shape which conforms to the shape of the outer periphery of the operation control button.

The Examiner rejected claims 1, 3 to 27 under 35 U.S.C. § 112, first paragraph because in the Examiner's view the specification does not provide support for a button moveable in a recess.

The Examiner rejected claims 1 and 3 to 27 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention. The Examiner states the claims are unclear because the movement of the button within the recess is not clearly defined.

The Examiner rejected claims 1, 3 to 6, 9 to 11, 13 to 17, 20, 23 to 25 and 27 under 35 U.S.C. § 102(b) as being anticipated by Abe.

The Examiner rejected claims 7 and 21 under 35 U.S.C. § 103 as being unpatentable over Abe in view of Seimitsu.

The Examiner rejected claims 8 and 22 under 35 U.S.C. § 103 as being unpatentable over Abe in view of Miyoshi.

The Examiner rejected claims 12 and 26 under 35 U.S.C. § 103 as being unpatentable over Abe in view of Hill.

The Examiner rejected claims 18 and 19 under 35 U.S.C. § 103 as being unpatentable over Abe in view of Chou.

The prior art relied upon by the Examiner in rejecting the claims on appeal are:

Chou	US 5,370,412	December 6, 1994
Hill	US 5,745,438	April 28, 1998
Abe	US 6,073,730	June 13, 2000
Miyoshi (as translated)	JP 4-48521	February 18, 1992
Seimitsu (as translated)	JP2000-268953	September 29, 2000

Appellant contends that one of ordinary skill would know how the control button works, and that therefore the recitation in the claims that the control button is movable within the recess meets the requirements of 35 U.S.C. § 112, first paragraph and 35 U.S.C. § 112, second paragraph.

Appellant also contends that Abe does not disclose a top surface defining a recess therein, the recess having a bottom wall and a side wall connected to the bottom wall.

Appellants further contends that a person of ordinary skill in the art would not have a reason to combine the teachings of Abe and the teachings of Seimitsu and that Seimitsu is not analogous art.

Appellant also contends that Miyoshi does not disclose an attachment arm made of an elastic material.

Appellant contends that Hill is not analogous art and that there is no reason to combine the teachings of Abe and Hill.

ISSUES

The first issue is whether the Appellant has shown that the Examiner erred in holding that the Specification does not provide support for how the button is moveable within the recess.

The second issue is whether the Appellant has shown that the Examiner erred in holding that claims 1 and 3 to 27 are unclear because the movement of the control button is moveable within the recess is not clearly defined.

The third issue is whether the Appellant has shown that the Examiner erred in finding that Abe discloses a top surface defining a recess therein, the recess having a bottom wall and a side wall connected to the bottom wall.

The fourth issue is whether the Appellant has shown that the Examiner erred in holding that Seimitsu is analogous art and that a person or ordinary skill in the art would have a reason to combine the teachings of Abe and Seimitsu.

The fifth issue is whether the Appellant has shown that the Examiner erred in finding that Miyoshi discloses an attachment arm made of an elastic material.

The sixth issue is whether the Appellant has shown that the Examiner erred in holding that Hill is analogous art and that there is a reason to combine the teachings of Abe and Hill.

FINDINGS OF FACT

Appellant's Specification discloses a control switch 40 that includes two portions: a bottom portion positioned in a recess 42 and a top button portion (Figure 3 to 7). The top button portion is moveable within the recess 42 and the shape of the recess conforms to the shape and outer periphery of the bottom portion of the control switch 40.

Abe discloses a bicycle switch mounting assembly 5 including a control device 20 which includes a top surface 38, push buttons 35, 36, control buttons 54, 55 and bottom case 31 (Figures 3 and 11). The top surface 38 is connected to the bottom case 31 by the operation of the screws 39 engaging holes 24 in the grip 21 to form a recess defined by top surface 38 side walls of top surface and the bottom case 31. A recess is formed by the top surface 38 and the bottom case 31. The push buttons 36 are disposed within the recess. The buttons 36 are moveable within the recess.

Seimitsu discloses a vibration insulating member 21 adhered and fixated to a fixing body 10 by means of adhesive 22 and upper faces 21c of the vibration members 21 adhered and fixated to a liquid-crystal panel 8 by means of adhesive 22 (paragraph 0026; Figure 3).

Miyoshi discloses a switch device including a button 12 attached to a spring 13 (Page 4, Figure 2). Miyoshi does not disclose that the spring is comprised of elastic material.

Hill discloses a threaded retention ring 16 utilized to secure member 17, 21 within a recess 32 (Figure 2).

ANALYSIS

Written description

The Examiner contends that there is no disclosure of a button moveable within the recess and therefore the claims lack written descriptive support. We initially note that the test for determining compliance with the written description requirement of 35 U.S.C. § 112, first paragraph, .. is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. *In re Kaslow*, 707 F.2d 1366, 1375(Fed. Cir. 1983). The content of the drawings may also be considered in determining compliance with the written description requirement. *Id.*

Figures 3 to 7 disclose a control button 40 that comprises two parts. The depiction of the two part button 40 would have conveyed to a person of ordinary skill in the art that the top portion is a push button and is movable within the recess. Therefore, we will not sustain this rejection of the Examiner.

Indefiniteness

The Examiner contends that the recitation of the control button moveable within the recess is imprecise because the specification and the drawings show the claimed button is not movable within the recess.

The Appellant argues that one of ordinary skill in the art would recognize that the button has a push button portion.

Claim 1 recites an operation control button with an outer periphery having a shape and that the shape of the recess conforms to this outer periphery. Claim 1 further recites that the button is movable within the recess. However, as argued by Appellant and as depicted in the drawings, it is the push button portion which is movable in the recess rather than the control button itself. In addition, the recess conforms to the shape of the non-push button portion. As such, in our view, the recitations of claim 1 are misdescriptive and therefore vague and indefinite. Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity. See *In re Venezia*, 530 F.2d 956, 958 (CCPA 1976).

In view of the foregoing, we will sustain the Examiner's rejection under 35 U.S.C. § 112, second paragraph.

Anticipation

The Appellant argues that Abe does not disclose a top surface defining a recess having a bottom wall and a side wall. The Appellant argues that the recess is formed by the top surface and the bottom case and as such the top surface does not define the recess as required by the claims.

However, claim 1 does not require that the top surface *alone* define the recess. The top surface does define the recess as the recess is formed by

the top surface and the bottom surface. Therefore, the top surface does define the recess at least in part.

In view of the foregoing, we will sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 102(a) as being anticipated by Abe.¹ We will also sustain the rejection as it is directed to claims 3 to 6, 9 to 11, 13 to 17, 20, 23 to 25 and 27 because the Appellant has not argued the separate patentability of these claims.

Obviousness

Rejection of claims 7 and 21

In support of this rejection, the Examiner relies on Seimitsu for teaching attaching one member to another member with adhesive. The Examiner also states that attaching one member to another is old and well known in the art.

We do not agree with the Appellant that Seimitsu is non-analogous art and that a person of ordinary skill in the art would have no reason to combine the teachings of Abe and Seimitsu.

¹ Appellants argue that the claims were improperly rejected under 35 U.S.C. § 102(b) instead of 35 U.S.C. § 102(a). Inasmuch as the Appellant states in the brief at page 16 that the claims are rejected under 35 U.S.C. § 102(a), we hold that the Appellants were on notice that the claims were rejected under 35 U.S.C. § 102(a) and the statement in the Final Rejection that the claims are rejected under 35 U.S.C. § 102(b) was harmless error on the part of the Examiner. *See In re Pearson*, 494 F.2d 1399, 1402 n.2, (CCPA 1974) (applicant was fully informed substantively, even if not formally, of the legal basis for the rejection).

The analogous-art test requires a showing that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* (“[I]t is necessary to consider ‘the reality of the circumstances,’--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” (quoting In re Wood, 599 F.2d 1032, 1036 (C.C.P.A. 1979))). Kahn, 441 F.3d at 986-87 (Fed. Cir. 2006). See also In re Clay, 966 F.2d 656, 659 (Fed. Cir. 1992) (“[a] reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.”).

In view of holding in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742 (2007) that “*any* need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed,” 127 S. Ct. at 1742, 82 USQ2d at 1397 (emphasis added), it is clear that the second part of the analogous art test as stated in *Clay, supra*, must be expanded to require a determination of whether the reference, even though it may be in a different field from that of the inventor's endeavor, is one which, because of the

matter with which it deals, logically would have commended itself to an artisan's (not necessarily the inventor's) attention in considering *any* need or problem known in the field of endeavor.

In the instant case, the problem faced by the inventor is attaching one member to another, the same problem that was addressed in the Seimitsu reference. In addition, because Seimitsu deals with attaching members together, the Seimitsu reference would logically commend itself to the problem that the inventor faced of attaching a control switch to a switch mounting recess.

We also agree with the Examiner that the use of adhesive to attach one member to another is notoriously well known.

Furthermore, as Seimitsu teaches that two members can be joined by the use of adhesive, we find ample reason for a person of ordinary skill in the art to combine the teachings of Abe and Seimitsu. We further note that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another *known in the field*, such as the substitution of the screws in Abe for adhesive as taught by Seimitsu, the combination must do more than yield a predictable result to render the invention patentable. See KSR, 127 S. Ct. at 1739, 82 USPQ2d at 1395.

In view of the foregoing, we will sustain the Examiner's rejection of claim 7 under 35 U.S.C. § 103 as being unpatentable over Abe in view of Seimitsu. We will also sustain this rejection as it is directed to claim 21 because the Appellant has not argued the separate patentability of this claim.

Rejection of claims 8 and 22

We will not sustain this rejection because Miyoshi does not disclose that the spring 13 is comprised of an elastic material as required by claims 8 and 22.

Rejection of claims 12 and 26

We will sustain the Examiner's rejection of claims 12 and 26 under 35 U.S.C. § 103 as being unpatentable over Abe in view of Hill. We are not persuaded by Appellant's argument that Hill is non-analogous art and that there is no motivation to combine the teachings of Abe and Hill.

Hill is concerned with the problem of securing a member 17, 21 within a recess 32 which is the same problem addressed by the Appellant. In addition, because Hill deals with securing a member within a recess, the Hill reference would logically commend itself to the problem that the inventor faced of securing a control switch in a switch mounting recess.

Furthermore, as Hill teaches that a member can be fastened securely within a recess by the use of a threaded retention ring, we find ample reason for a person of ordinary skill in the art to combine the teachings of Abe and Hill i.e. to provide a secure means to fasten control device 20 within the recess.

In view of the foregoing, we will sustain the Examiner's rejection of claim 12 as being unpatentable under 35 U.S.C. § 103 over Abe in view of Hill. We will also sustain this rejection as it is directed to claim 26 because the Appellant has not argued the separate patentability of this claim.

Rejection of claims 18 and 19

We will sustain the rejection of claims 18 and 19 under 35 U.S.C. § 103 as being unpatentable over Abe in view of Chou because the Appellant advances the same arguments in response to these rejections that we found unpersuasive when considering the 35 U.S.C. § 102(a) rejection.

AFFIRMED-IN-PART

JRG

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